

Remarks/Arguments

A. Pending Claims

Claims 36, 51, 61 and 71-74 have been amended. Claim 59 has been cancelled. Claims 36-58 and 60-75 are pending in the case.

B. The Invention Is Directed To Statutory Subject Matter

The Examiner rejected claims 71 and 72 under 35 U.S.C. §101 as being directed to non statutory subject matter.

Applicant has amended claims 71 and 72. Applicant submits that the claims are drawn to statutory subject matter. Applicant respectfully requests the rejections under 35 U.S.C. §101 be withdrawn.

C. The Claims Are Not Indefinite Pursuant to 35 U.S.C. §112, Second Paragraph

The Examiner rejected claims 36-75 under 35 U.S.C. §112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Concerning claim 36, the Office Action states:

the limitation “wherein the interface program is configured to receive data from the channel and a command that will initiate a business transaction” is indefinite since it does not specify whether the interface program is also configured to receive the command that will initiate a business transaction. Furthermore, the claim fails to ascertain the relationship the command that will initiate a business transaction has with any other element of the claimed invention.

Applicant respectfully disagrees with this rejection. Nevertheless, to expedite prosecution of this

application, Applicant has amended claim 36 for clarification. Applicant respectfully requests removal of the rejection of claim 36 and the claims dependent thereon.

Concerning claim 51, the Office Action states:

The 112(second) rejection concerns the indefiniteness arising due to lack of relationship amongst the process steps (gap between the steps). For example, the limitation “determining whether a portion of received data includes values in a list of allowable values”, which has no connection to any other step of the claim. Likewise, the limitation “wherein each interface program is communicatively coupled to one of a plurality of channels” does not relate to any subsequent steps of the claim. The limitation “flattening the data” is performed without any relation to the determining step. The limitation “wherein the program instructions comprise a plurality of objects” is irrelevant to any of the process steps of the claim.

Applicant respectfully disagrees with these rejections. “[I]t is not essential to a patentable combination that there be interdependency between the elements of the claimed device or that all the elements operate concurrently toward the desired result.” *Ex parte Nolden*, 149 U.S.P.Q. 378, 380 (Bd. Pat. App. and Intf. 1965). Moreover, a claim does not necessarily fail to comply with 35 U.S.C. §112, second paragraph because the various elements “do not function simultaneously, are not directly functionally related, do not directly intercooperate, and/or serve independent purposes.” *Ex parte Huber*, 148 U.S.P.Q. 447, 448-49 (Bd. Pat. App. and Intf. 1965). Therefore, Applicant respectfully disagrees that all the features recited in claim 51 must be connected with, related to, or “relevant” to other features of the claim. In addition, Applicant respectfully points out, according to MPEP §2173.02:

The essential inquiry pertaining to this requirement is whether the claims set out and circumscribe a particular subject matter with a reasonable degree of clarity and particularity. Definiteness of claim language must be analyzed, not in a vacuum, but in light of:

- (A) The content of the particular application disclosure;
- (B) The teachings of the prior art; and
- (C) The claim interpretation that would be given by one possessing the ordinary level skill in the pertinent art at the time the invention was made.

In reviewing a claim for compliance with 35 U.S.C. 112, second paragraph, the examiner must consider the claim as a whole to determine whether

the claim apprises one of ordinary skill in the art of its scope and, therefore, serves the notice function required by 35 U.S.C. 112, second paragraph, >by providing clear warning to others as to what constitutes infringement of the patent<. See, e.g., *Solomon v. Kimberly-Clark Corp.*, 216 F.3d 1372, 1379, 55 USPQ2d 1279, 1283 (Fed. Cir. 2000).

Applicant submits that the features “determining whether a portion of received data includes values in a list of allowable values”, “wherein each interface program is communicatively coupled to one of a plurality of channels”, “flattening the data”, and “wherein the program instructions comprise a plurality of objects”, in combination with the other features of claim 51, are set out with reasonable a reasonable degree of clarity and particularity. Applicant respectfully submits that the Office Action does not show why a person possessing the ordinary level of skill in the pertinent art with the Applicant’s specification would not have reasonable notice as to the scope of the claims. Nevertheless, to expedite prosecution of the present application, Applicant has amended claim 51 for clarification. Applicant respectfully requests removal of the rejection of claim 51 and the claims dependent thereon.

Concerning claim 61, the Office Action states:

the outcome of the determination has no relationship to the any limitation(s) that follows. In other words, the determining step does not affect the transforming data step and therefore also do not affect the transferring and processing steps. In absence of one or more steps that relate the determining step to the aforementioned other steps the claim 61 as a whole and associated dependent claims 62 and 75 are rendered indefinite.

Applicant respectfully disagrees with these rejections. As noted above with respect to claim 51, a claim is not indefinite merely because various elements “do not function simultaneously, are not directly functionally related, do not directly intercooperate, and/or serve independent purposes.” *See Ex parte Huber*, 148 U.S.P.Q. at 448-49. Nevertheless, to expedite prosecution of this application, Applicant has amended claim 61 for clarification. Applicant respectfully requests removal of the rejection of claim 61 and the claims dependent thereon.

The Examiner rejected claims 71 and 72 are “not sufficiently precise due to the

combining of two different statutory classes of invention in a single claim.” Applicant has amended claims 71 and 72. Applicant respectfully requests removal of the rejections of claim 71 and 72.

Applicant submits that the pending claims are patentable pursuant to 35 U.S.C. §112 and respectfully requests the removal of rejections on these grounds.

D. The Claims Are Not Obvious Over McDonough In View of Thorne Pursuant To 35 U.S.C. § 103(a)

The Examiner rejected claims 36-70 under 35 U.S.C. 103(a) as obvious over U.S. Patent No. 6,115,693 to McDonough et al. (hereinafter “McDonough”) and further in view of U.S. Patent No. 6,100,891 to Thorne (hereinafter “Thorne”).

To reject a claim as obvious, the Examiner has the burden of establishing a *prima facie* case of obviousness. *In re Warner*, 154 U.S.P.Q. 173, 177-78 (C.C.P.A. 1967). To establish a *prima facie* obviousness of a claimed invention, all claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974); MPEP § 2143.03. In addition, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Amended claim 36 recites: “a middleware program communicatively coupled to the server, wherein the middleware program comprises a domain file, wherein the domain file comprises a list of allowable values associated with one or more business transactions.” The cited art does not appear to teach or suggest at least these features of claim 36, in combination with the other features of the claim.

Amended claim 36 also recites: "wherein the middleware program determines whether portions of the received data include allowable values based on the domain file". The cited art does not appear to teach or suggest at least these features of claim 36, in combination with the other features of the claim.

The Office Action states:

McDonough, while teaches the system substantially as claimed, fails to explicitly, recite a domain file comprising a list of allowable values associated with one or more business transactions and that the middleware program determines whether portions of the received data include allowable values based on the domain file validates portions of the data, transforms the data into a form required by the server, and transmits the transformed data to the server.

The Office Action attempts to rely in part on Thorne to overcome the deficiencies in the teachings of McDonough with respect to the above-quoted feature of claim 36. The Office Action states:

Thorne discloses the determining of allowable values associated with business transaction is performed by the interface program....

The Office Action appears to acknowledge that neither McDonough nor Thorne disclose a middleware program determining whether portions of received data include allowable values based on a domain file. The Office Action nevertheless states:

....The claimed invention requires that the determining step is performed by the middleware (i.e. context manager of McDonough). However, it has been held that rearranging parts of an inventions involves only routine skill in the art. *In re Japikse*, 181 F.2d 1019, 86 USPQ 70 (CCPA 1950). In this instance, rearranging the location of performing determination of the allowable values from the interface program to the middleware program would involve only routine skill in the art per the court ruling.

In view of the teaching of Thorne and further in view of *In re Japiske* as discussed above, it would have been obvious to one having ordinary skill in the art at the time the invention was made to implement the aforementioned feature in the middleware because the invention would perform regardless of where the stated function is performed whether in the interface (as per Thorne) or if modified to

incorporate into the middleware.
(underline in original, italics added).

The Office Action appears to take the position that because determining whether the received data include allowable values could be performed in middleware, it would have been obvious to modify the system of McDonough to have the context manager perform this function. Applicant disagrees with the Office Action's position. "The mere fact that a worker in the art could rearrange the parts of the reference device to meet the terms of the claims on appeal is not by itself sufficient to support a finding of obviousness. The prior art must provide a motivation or reason for the worker in the art, without the benefit of appellant's specification, to make the necessary changes in the reference device." *Ex parte Chicago Rawhide Mfg. Co.*, 223 USPQ 351, 353 (Bd. Pat. App. & Inter. 1984) (emphasis added). Applicant respectfully submits that the cited art does not provide a motivation or suggestion to modify McDonough to include a middleware program determining whether portions of received data include allowable values based on a domain file.

The Office Action further states:

mere shifting the location of the functionality of determining the allowable value from the interface program (per Thorne) to the context manager would only involve a routine skill in the art since it amounts to rearranging parts of the combined inventions and that one of ordinary skill in the art would have recognized benefits of having the determining portions of the received data include allowable values based on the domain file performed at the middleware program.

As noted above, merely because parts of a system could be rearranged is not sufficient to support a finding of obviousness. As to the Office Action's statement that "one of ordinary skill in the art would have recognized benefits of having the determining portions of the received data include allowable values based on the domain file performed at the middleware program", the Examiner appears to rely on facts within the personal knowledge of the Examiner. Pursuant to MPEP §2144.03, Applicant respectfully requests the Examiner provide support for his assertion either by affidavit or by references brought to the Applicant's attention, or that the rejection be

removed.

For at least the reasons stated above, Applicant submits that claim 36 is allowable over the cited art. Applicant respectfully requests removal of the rejections of claim 36 and the claims dependent thereon.

Amended claim 51 recites: “wherein the carrier medium comprises at least one file that stores a list of allowable values, wherein the program instructions are computer-executable to implement: receiving data from one interface program of a plurality of interface programs, wherein each interface program is communicatively coupled to one of a plurality of channels, wherein the data is received by the interface program from the channel to which it is coupled; determining whether a portion of received data includes values in the list of allowable values.” For reasons similar to those set forth above with respect to claim 36, Applicant submits that the cited art does teach or suggest at least this feature of claim 51, in combination with the other features of the claim.

Amended claim 61 recites: “transferring the data to the middleware program; determining whether a portion of the data includes values in a list of allowable values in the domain file, wherein if the portion of the data does not include values in a list of allowable values, notifying the user interface, and receiving corrected data.” For reasons similar to those set forth above with respect to claim 36, Applicant submits that the cited art does not teach or suggest at least this feature of claim 61, in combination with the other features of the claim.

E. Summary

Applicant submits that all claims are in condition for allowance. Favorable consideration is respectfully requested.

If an extension of time is needed, Applicant requests the appropriate extension of time. A fee authorization is enclosed for additional claims fees. If any other fees are required, please charge those fees to Meyertons, Hood, Kivlin, Kowert & Goetzel, P.C. Deposit Account Number 50-1505/5053-30700/EBM.

Respectfully submitted

Eric B. Meyertons
Reg. No. 34,876

Attorney for Applicant

MEYERTONS, HOOD, KIVLIN, KOWERT & GOETZEL, P.C.
P.O. Box 398
Austin, TX 78767-0398
(512) 853-8800 (voice)
(512) 853-8801 (facsimile)

Date: December 8, 2004